



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,112	09/18/2003	Mark Davis	12099-003002	7138
26161	7590	12/26/2008	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				STRODER, CARRIE A
ART UNIT		PAPER NUMBER		
		3689		
			NOTIFICATION DATE	DELIVERY MODE
			12/26/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	10/666,112	DAVIS, MARK	
	Examiner	Art Unit	
	CARRIE A. STRODER	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 31-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 31-53 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 18 September 2003, wherein:

Claims 1-30 are currently cancelled.

Claims 31-53 are currently pending.

Information Disclosure Statement

1. The information disclosure statement filed 18 September 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The applicant did not include copies of the non-patent literature cited in the information disclosure statement.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are blurry, illegible, and partially hand-written. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid

Art Unit: 3689

abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 31-53 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "common user interface elements" referred to in claim 31 is vague and undefined.

5. **Claim 43 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is confusing as written. The Examiner cannot determine how a hyperlink enables using a handheld device. Therefore, Examiner assumes for the purposes of examination that the Applicant intended to use a network to access a website, thereby enabling the user in the physical store to use a handheld device to scan products and obtain information related thereby.

Art Unit: 3689

6. **Claims 45-49 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 45-49 each refer to a "mechanism," which is vague and undefined.

7. **Claims 50-52 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant states that the "displaying, enabling, and providing" are done on a mobile device. However, there is no "displaying, enabling, or providing" in either claim 52 or claim 31. Examiner assumes applicant intended to access the website using a wireless network via a mobile device.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 31-53 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) involve a particular machine, or (2) transform underlying subject matter (such as an article

Art Unit: 3689

or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 31-53, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claims 31-35, 37-46, and 50-51 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Cartmell et al. (US 20020103820), in view of Shuster et al. (US 20010034657), and further in view of WebMD (www.webmd.com).

Referring to claim 31:

Cartmell teaches a method comprising

Art Unit: 3689

registering a set of Internet domain names containing some words in common and some different words related to health care (paragraphs 24 and 28-29). Furthermore, the Examiner asserts that having a domain name with words **related to health care** is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different

Art Unit: 3689

descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that having some words in a domain name related to health care can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Cartmell does not teach; however, Shuster teaches licensing authorizing the use of the different independently registered domain names respectively to by different health-related enterprises, the enterprises including at least one of the following: a healthcare sales organization[[s]], a healthcare delivery organization[[s]], and a healthcare manufacturer[[s]],

Art Unit: 3689

the domain names containing at least one sequence of at least one character in common and respectively containing at least one sequence of at least one character that is different between domain names (paragraph 3). Furthermore, the Examiner asserts that the name of the user to whom a domain name is licensed to is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and

Art Unit: 3689

the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that licensing a domain name to certain groups adds little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Cartmell and Shuster do not teach; however, WebMD teaches establishing at least some common user interface appearance elements for web sites associated with the different respective domain names (Sections I and II, where the WebMD name is a common element), and

Art Unit: 3689

marketing the different domain names for use by consumers in a way that generates strong common brand identity among them (Section I and II, where marketing is interpreted to include the name of the website, which webmd.com and women.webmd.com, have in common).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 32:

Claim 32 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell, Shuster, and WebMD do not explicitly teach in which at least some sequences that differ for respective domain names refer to symptoms, diseases, or treatments. However, having differing sequences for domain names in reference to symptoms, diseases, or treatments, is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable

Art Unit: 3689

weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that having differing sequences for domain names in reference to symptoms, diseases, or treatments, can add little, if anything, to the claimed acts or steps and

Art Unit: 3689

thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 33:

Claim 33 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including maintaining a main website having one of the domain names, and including in the main website a link to one of the websites having another of the domain names (Section III).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 34:

Claim 34 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches in which websites having the respective domain names provide users of the websites with information about symptoms, diseases, or treatments associated with the symptoms, diseases, or treatments to which the different sequences of the domain names refer (Section IV).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Furthermore, the type of information provided is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ

Art Unit: 3689

401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the type of information provided can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the

Art Unit: 3689

steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 35:

Claim 35 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and WebMD do not teach; however Shuster teaches in which authorizing includes licensing the domain names (paragraph 3).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 36:

Claim 36 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however WebMD teaches in which authorizing includes granting sponsorship rights for the domain names (Section VI).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 37:

Claim 37 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches in which the domain names are used for websites that comprise a network of websites (pages 1-4; WebMD and its associated websites are interpreted as a network of websites).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 38:

Claim 38 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Art Unit: 3689

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the websites, providing to a user at least one of a promotional offer for a product or service offered by one of the health-related enterprises, information sheets providing printed information about a symptom, disease, or treatment, or appointment information for a healthcare provider (Section V; where printing out information from the medical encyclopedia is interpreted as an information sheet).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 39:

Claim 39 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches including on at least one of the web sites, providing to a user at least one of a coupon for product purchase, an information sheet, or prescription information to be provided by the user to

Art Unit: 3689

a healthcare provider for use in writing a prescription or otherwise facilitating a product purchase (Section V).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Furthermore, the manner in which the information sheet, coupon, or prescription information is used is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive

Art Unit: 3689

material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the manner in which the information sheet, coupon, or prescription information is used can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 40:

Claim 40 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing to a healthcare provider at least one of a coupon for product purchase, an information sheet, or prescription information to be accessed by the healthcare provider for use in writing a prescription or otherwise facilitating a product purchase for a client or patient (Section V).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Furthermore, the manner in which the information sheet, coupon, or prescription information is used is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all

Art Unit: 3689

claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the manner in which the information sheet, coupon, or prescription information is used can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish

Art Unit: 3689

over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 41:

Claim 41 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing to a user a sales offer for a textbook or electronic information about a symptom, disease, or treatment (Section V).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 42:

Claim 42 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing to a user a sales offer to purchase a product associated with a symptom, disease, or treatment (Section VI; where Examiner takes Official Notice that a sponsorship on a website includes an advertisement which provides a sales offer for products associated with the website being sponsored).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Furthermore, the type of product purchased is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ

Art Unit: 3689

401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the type of product purchased can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps

Art Unit: 3689

are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 44:

Claim 44 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing a hyperlink to a web site that offers for sale products of at least one of the different health-related enterprises (Section VI; where Examiner takes Official Notice that a sponsorship on a website includes a hyperlink which provides a sales offer for products).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Art Unit: 3689

Furthermore, the type of product purchased is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious

Art Unit: 3689

functional relationship between the descriptive material and the substrate.

The Examiner asserts that the type of product purchased can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 45:

Claim 45 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing a mechanism to communicate with one of the health delivery organizations (Section VII; where WebMD's chat option provides said mechanism).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have

Art Unit: 3689

found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Furthermore, the organization communicated with is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and

Art Unit: 3689

the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the organization communicated with can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 46:

Claim 46 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing a

Art Unit: 3689

mechanism to schedule appointments with one of the health delivery organizations (Section VII; where WebMD's chat option provides said mechanism).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 48:

Claim 48 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing a mechanism for physician referrals (Section VII; where WebMD's chat option provides said mechanism).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 49:

Art Unit: 3689

Claim 49 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches also including on at least one of the web sites, providing a mechanism for a user to identify himself to a health-care related enterprise or to a main one of the websites and to receive additional information or discount offers in response to identifying himself (Section VII; where WebMD's chat option provides said mechanism).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 50:

Claim 50 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches in which the displaying, enabling, and providing are done on an electronic network (Pages 1-4; where the electronic network is the internet).

Art Unit: 3689

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 51:

Claim 51 is dependent on claim 50; therefore the rejection of claim 50 is incorporated herein.

Cartmell and Shuster do not teach; however, WebMD teaches in which the network comprises the World Wide Web (Pages 1-4; where the electronic network is the internet).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, and WebMD as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

12. **Claim 43 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Cartmell et al. (US 20020103820), in view of Shuster et al. (US 20010034657), further in view of WebMD (www.webmd.com) and further in view of Ruppert et al. (US 5424524).

Referring to claim 43:

Claim 43 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell, Shuster, and WebMD do not teach; however Ruppert teaches also including on at least one of the web sites, providing a hyperlink to a web site of a physical store to enable a user in the physical store to use a handheld device to scan products and obtain information related to the website (col. 1, lines 67-68 thru col. 2, lines 1-14; where the current price list is interpreted as the information related to the website).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, WebMD, and Ruppert as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

13. **Claim 47 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Cartmell et al. (US 20020103820), in view of Shuster et al. (US 20010034657), further in view of WebMD (www.webmd.com), and further in view of Evans (US 5924074).

Referring to claim 47:

Art Unit: 3689

Claim 47 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Cartmell, Shuster, and WebMD do not teach; however, Evans teaches also including on at least one of the web sites, providing a mechanism for users to add information to a medical record (col. 13, lines 22-30 and col. 5, lines 8-13).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, WebMD, and Evans as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Referring to claim 53:

Claim 53 is dependent on claim 50; therefore the rejection of claim 50 is incorporated herein.

Cartmell, Shuster, and WebMD do not teach; however, Evans teaches also including using the websites in connection with delivery of healthcare through a physician (col. 5, lines 8-13).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, WebMD, and Evans as a whole to produce the invention as

Art Unit: 3689

claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

14. **Claim 52 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Cartmell et al. (US 20020103820), in view of Shuster et al. (US 20010034657), further in view of WebMD (www.webmd.com), and further in view of Brown et al. (US 20010013001).

Referring to claim 52:

Claim 52 is dependent on claim 31; therefore the rejection of claim 31 is incorporated herein.

Although Cartmell, Shuster, and WebMD do not teach, Brown teaches in which the displaying, enabling, and providing are done on a mobile device (paragraph 11).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Cartmell, Shuster, WebMD, and Brown as a whole to produce the invention as claimed with a reasonable expectation of providing a more flexible method of registering a set of internet domain names.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Perkowski (US 5950173); and
- b. Papierniak et al. (US 6169997).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689